

### **Remarks**

The foregoing amendments and following remarks are responsive to the December 11, 2007 Final Office Action and the March 6, 2008 Advisory Action. Applicants respectfully request reconsideration.

### **Status of the Claims**

Claims 2-5 and 14-17 are amended. Claims 18-21 are added. Claims 1 and 13 are cancelled. Claims 10-12 were cancelled previously. Claims 6-9 were withdrawn, without prejudice, and may be subject to rejoinder. Claims 2-5 and 14-21 are pending.

### **Support for Amendments to the Claims/Added Claims**

Support for the amendments to Claims 2-5 and 14-17, and new Claims 18-21, is found on page 3, lines 17-19 and page 4, lines 15-20 of the specification. No new matter is added.

### **Rejections under 35 U.S.C. § 112, first paragraph**

Claims 16-17 were rejected as containing subject matter which was not described in the specification. On page 3, lines 17-19, and page 4, lines 15-20, the nonaromatic dicyclic compounds are described as useful in both cosmetic or pharmaceutical preparations. Accordingly, the amounts useful in the cosmetic compositions are also attributable to the pharmaceutical preparations. Therefore, no new matter has been added. The Examiner is respectfully requested to reconsider and withdraw the rejection.

### **Rejections under 35 U.S.C. § 102(b)**

Claims 1 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Publication No. XP-002298686 (Garland). Claims 2-5 and 14-17 are amended to clarify the invention. Claims 1 and 13 are cancelled, rendering the rejection moot.

For a reference to anticipate, each element of the claim must be present. Garland relates to a methyl-substituted bicyclohexane compound (2-methyl-bicyclohexyl). Since Garland does not disclose hexamethyl dicyclopentane or hexamethyl dicyclohexane, Garland fails to anticipate the invention as claimed, and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejections under 35 U.S.C. § 103(a)

Claims 2-5 and 14-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Garland in view of International Publication No. WO 89/00077 (Luisi).

Garland relates to a methyl-substituted bicyclohexane compound (2-methyl-bicyclohexyl). Luisi relates to a lecithin gel that includes an organic solvent and water, to which an active ingredient may be added before gelation.

To support a conclusion of obviousness, either (1) the references must expressly or impliedly suggest the claimed combination, or (2) the Examiner must present a convincing line of reasoning as to why a skilled worker would have found the claimed invention to have been obvious, in view of the teachings of the references.

The Examiner correctly asserts that Garland does not teach hexamethyl bicyclopentane or hexamethyl dicyclohexane, and that Garland does not teach the amounts of bicyclohexyl compounds in compositions. In support of the rejection, the Examiner relies on Luisi as teaching a suitable amount of a bicyclohexyl compound for a composition.

Luisi discloses, as an organic solvent for the lecithin or lecithin-containing material, both aromatic and aliphatic compounds, including lauric acid ethyl ester, lauric acid butyl ester, myristic acid ethyl ester, myristic acid isopropyl ester, palmitic acid isopropyl ester, stearic acid butyl ester, isooctane, cyclopentane, cyclohexane, cycloheptane, cyclooctane, cyclodecane, methylcyclohexane, tert-butylcyclohexane, bicyclohexyl, phenylcyclohexane, 1,3,5-triisopropylbenzene, octylbenzene, trans-decalin,  $\text{CH}_3(\text{CH}_2)_n\text{CH}_2$ , wherein n is an integer from 2 to 15, 2,3-dimethylbutane, 1-

hexene, 1-octene, 1,7-octadiene, (1R)-(+)-trans-pinane, (1R)-(+)-cis-pinane, tripropylamine, tributylamine, triisobutylamine, trioctylamine, N,N-dioctylamine, dibutylether, 2-decenylsuccinic anhydride, sunflower oil and olive oil.

From the lengthy list of aromatic and aliphatic organic solvents in Luisi, the Examiner has located an unsubstituted bicyclohexyl compound which allegedly represents a comparable compound to Applicants' hexamethyl-substituted compounds. When considering the reference as a whole, however, there is no teaching, suggestion, or line of reasoning provided to one skilled in the art to select the unsubstituted bicyclohexyl compound of Luisi over all the other possible compounds disclosed. If one skilled in the art had the foresight to select the unsubstituted bicyclohexyl compound from the compounds of Luisi, and determine a suitable amount of the compound for incorporation into a composition, the result still would not reach the invention, since neither Garland nor Luisi discloses, teaches or suggests hexamethyl dicyclopentane or hexamethyl dicyclohexane as claimed.

In addition, the Examiner alleged that one would have been motivated to determine the effective amounts of bicyclohexyl compounds, since Luisi discloses that bicyclohexyl compounds are known as solvents. The allegation, however, was made despite the lack of express or implied teaching or suggestion of hexamethyl dicyclopentane or hexamethyl dicyclohexane in either Garland or Luisi. Thus, the unsubstituted bicyclohexyl compound and the respective amounts disclosed by Luisi, in combination with Garland, also do not reach the invention as claimed.

In addition, there is also no teaching or line of reasoning why one skilled in the art, when considering the Luisi reference as a whole, would have expected or would have been apprised of the significance, that the unsubstituted bicyclohexyl compound, out of all the aromatic and aliphatic solvents disclosed by Luisi, might provide stability to a composition when the unsubstituted bicyclohexyl compound is substituted with six methyl groups, as found by Applicants, as exemplified in the Examples (pages 29-30), and as set forth in Claims 2-5 and 14-17. There is simply no teaching or suggestion, or motivation provided by either Garland or Luisi, or the combination thereof, however, to

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substitute six methyl groups on Luisi's unsubstituted bicyclohexyl compound or to further substitute the methyl-substituted compound of Garland with five methyl groups to arrive at Applicants' compounds. In the absence of such disclosure, there is inadequate support for the Examiner's position, and therefore, a *prima facie* case has not been made.

In view of the foregoing, the addition of Luisi to Garland cannot be said to render obvious the invention as claimed. When considering the disclosures of Garland and Luisi as a whole, whether individually or in combination, it would not have been obvious to one skilled in the art to arrive at the invention with any reasonable expectation of success, absent Applicants' disclosure, and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

#### Fees

A Request for Continued Examination and requisite fee are enclosed. A Petition for a One-Month Extension of Time and requisite fee are also enclosed. No additional fees are believed due, but the Commissioner is authorized to charge any fees deemed due (or credit any balance) to Deposit Account No. 50-1177.

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Conclusion

It is respectfully submitted that Claims 2-5 and 14-21 are in condition for allowance. A Notice of Allowance is respectfully requested. The Examiner is invited to contact Applicants' attorney at the telephone number indicated below if anything further is needed to advance the allowance thereof.

Respectfully submitted,

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Date

  
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